

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte MARY C. FREDERICKSON

Appeal 2007-2899
Application 09/904,122
Technology Center 3600

Decided: September 25, 2007

Before ERIC GRIMES, NANCY J. LINCK, and RICHARD M.
LEBOVITZ, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to an apparatus for freeing a fishing lure from obstructions. The Examiner has rejected the claims as obvious. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

BACKGROUND

A number of fishing lures are “designed to sink to the bottom of lakes or streams and, as they are dragged along, may get caught on rocks, weeds,

and the like. Freeing lures from such obstacles is a constant problem” (Specification 1). The Specification discloses an “apparatus for freeing the lures without harm to the lures” (*id.*).

DISCUSSION

1. CLAIMS

Claims 1, 4-9, and 11-16 are pending and on appeal. Claims 1 and 11 are representative, and read as follows:

1. Apparatus for freeing a fishing lure and hook from obstructions comprising in combination:

- a sleeve;
- a slit in the sleeve for receiving a fishing line secured to the lure;
- a plurality of chain elements secured to the sleeve including a plurality of links, and each link includes a barb; and
- a line secured to the sleeve for lowering the sleeve on the fishing line and its chain elements to free the lure from obstructions.

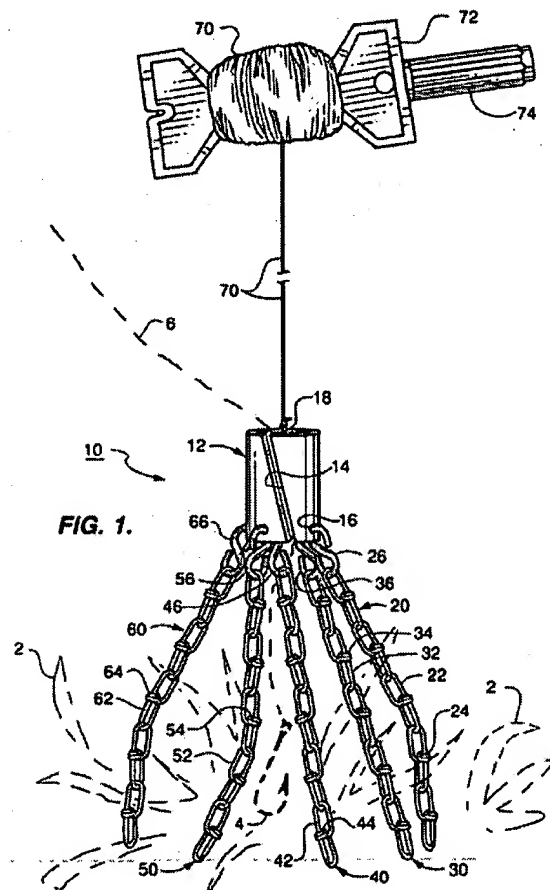
11. Apparatus for freeing a fishing lure and hook from obstructions comprising in combination:

- a sleeve;
- a slit in the sleeve for receiving a fishing line having a snagged lure and hook;
- a line secured to the sleeve for lowering the sleeve on the fishing line;
- a plurality of chain elements secured to the sleeve remote from where the line is secured to the sleeve; and
- a plurality of barbs on the plurality of chain elements.

Thus, claim 1 is directed to a device for freeing a fishing lure snagged on an obstruction. The device has a sleeve with a slit capable of receiving

the fishing line attached to the snagged lure. The sleeve has a plurality of chains attached to it, with each link in the chains having a barb. A retrieving line is secured to the sleeve, such that the sleeve and its attached chains can be lowered along the fishing line attached to the trapped lure, allowing the chains to free the lure from an obstruction. Claim 11 recites a similar device, except that claim 11 does not state that each chain link has a barb.

Figure 1, reproduced below, shows an example of the claimed device:

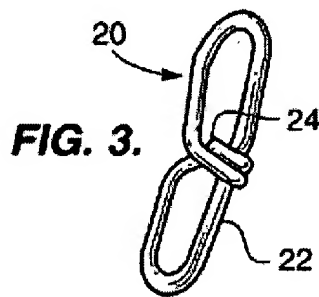


The figure shows sleeve 12 with slit 14 attached to retrieving line 70. The retrieving line is wrapped around reel 72, which is attached to handle 74. Chains 20, 30, 40, 50, and 60 are attached to sleeve 12. The figure

shows, in phantom, fishing line 6 attached to lure hook 4, which is entrapped in weeds 2. Figure 1 also shows barbs 24, 34, 44, 54, and 64 on the chains.

It is well settled that “claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983) (citation omitted). The meaning of the claim term “barb” is an issue in this appeal. However, the Specification does not define the term “barb,” or state the purpose of the barbs on the chain links. Moreover, the barbs’ function, if any, is not clear from viewing Figure 1.

Figure 3, reproduced below, shows a close-up example of one of the chain links 22 and its associated barb 24:



As with Figure 1, the barb shown in Figure 3 does not appear to have a sharp point. Rather, it merely appears to be the cut end portion of a wire used to form an individual link.

Therefore, when given its broadest reasonable interpretation consistent with the Specification, we interpret the term “barb” as encompassing not only pointed structures like those on barbed wire or

fishing hooks, but also the cut end portion of wire used to form an individual chain link of the type shown in Figure 3.

2. PRIOR ART

The Examiner relies on the following references:

O'Brien	US 4,598,493	Jul. 8, 1986
Clayton	US 3,987,573	Oct. 26, 1976
Shirk	US 2,097,536	Nov. 2, 1937

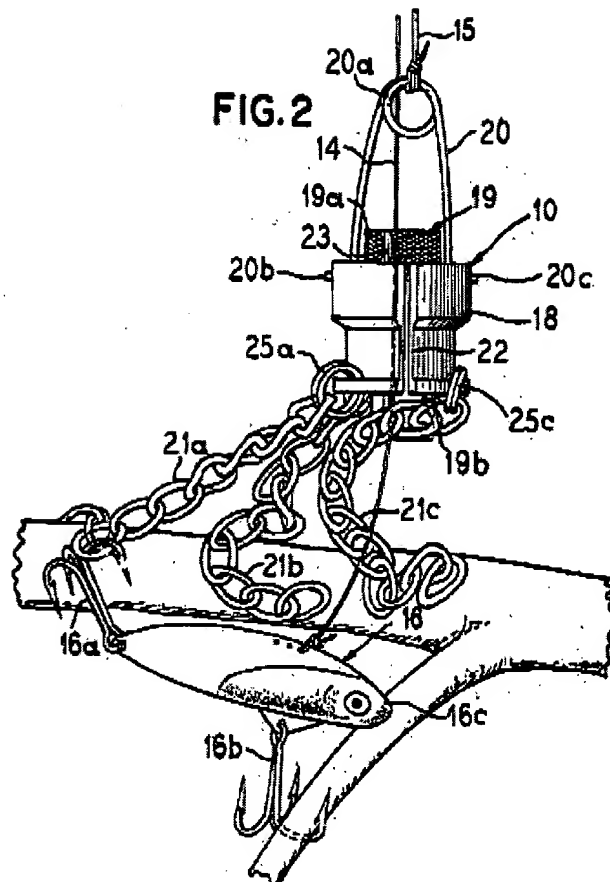
3. OBVIOUSNESS -- CLAIMS 1, 4, 5, 7, 9-13, 15, AND 16

Claims 1, 4, 5, 7, 9, 11-13, 15, and 16 stand rejected under 35 U.S.C. § 103 as obvious in view of O'Brien and Clayton (Answer 3).

The Examiner cites O'Brien as disclosing "an apparatus for freeing a fishing lure" comprising all of the elements of claims 1 and 11 except for the recited barbs (Final Rejection 2-3). The Examiner cites Clayton as disclosing a fishing lure retriever having "a plurality of barbs 26 on the chain links 23, 25" (*id.* at 3).

The Examiner concludes that "it would have been obvious to provide O'Brien with barbs as shown by Clayton to engage the fishing lure" (*id.*). The Examiner further concludes that although Clayton "does not show a barb on every link, it would have been obvious to provide a barb on every link for multiplied effect" (*id.*, citing *In re Harza*, 274 F.2d 669 (CCPA 1960)).

We agree with the Examiner that one of ordinary skill in the art would have considered the device recited in claims 1 and 11 obvious in view of O'Brien and Clayton. Figure 2 of O'Brien is reproduced below:



The figure shows a fishing lure retrieving device having the claimed sleeve 18, slit 22, retrieving line 15, and plurality of chains 21a, 21b, and 21c. O'Brien's device is very similar to Appellant's but lacks the plurality of barbs recited in claims 1 and 11, or a barb on each chain link, as recited in claim 1. However, Figure 1 of Clayton is reproduced below:

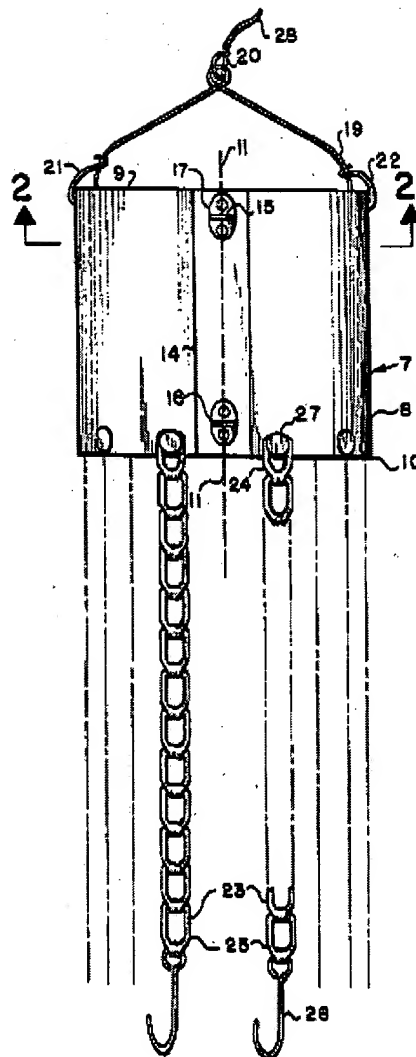


FIG. 1

The figure shows a fishing lure retrieving device having a cylinder 8, a slit 14 in the cylinder 8, a line 28 attached to the cylinder 8 by a wire 19, a plurality of attached chains 23, and a hook 26 at the end of each chain. Clayton states that “[a]n unbarbed hook hook 26 having substantially the configuration of a fish hook may be attached to the loose end 25 of chain 23. The purpose or function of these hook hooks 26 is in the retrieving of fishing lures having weedless hooks” (Clayton, col. 2, ll. 48-53).

Recently addressing the issue of obviousness, the Supreme Court reaffirmed the conclusion “that when a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007) (quoting *Sakraid v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976)). The Court reasoned that

[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.

Id. at 1742.

The Court also advised that “[a] person of ordinary skill is . . . a person of ordinary creativity, not an automaton.” *Id.* Thus, the obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”

Id. at 1741.

We agree with the Examiner that one of ordinary skill would have recognized from Clayton that it would be useful to attach a plurality of hooks (i.e., barbs) to the chains of a fishing lure retrieving device, such as disclosed by O’Brien or Clayton, in order to retrieve trapped lures having weedless hooks. We also agree with the Examiner that one of ordinary skill, being a person of ordinary creativity and common sense, would have inferred that including a hook on each chain link, in the manner recited in

claim 1, would have multiplied the device's retrieving capability; i.e., the increased number of hooks would increase the likelihood of retrieving snagged lures with weedless hooks.

We note that Clayton describes "hook hooks 26" as being "unbarbed" (Clayton, col. 2, l. 48). However, Clayton also states that the hook hooks 26 "hav[e] substantially the configuration of a fish hook" (*id.* at col. 2, l. 49). As discussed above, when the term "barb" is given its broadest reasonable interpretation in light of the Specification, it encompasses pointed structures like those on barbed wire or fishing hooks. The term "barb" therefore also encompasses the pointed substantially fish hook-configured structures on the chains of Clayton's device. Because we agree with the Examiner that one of ordinary skill would have considered it obvious to have a plurality of such barbs on a fishing lure retrieving device of the type disclosed by O'Brien and Clayton, we agree with the Examiner that claims 1 and 11 would have been obvious to one of ordinary skill viewing those references.

Appellant argues that "the O'Brien patent requires an insert. The present invention defined by claims 1 and 11 do[es] not include such an element" (Br. 7). We are not persuaded by this argument.

Claims 1 and 11 both use the term "comprising" to describe the claimed invention. It is well settled that "'[c]omprising' is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim." *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501 (Fed. Cir. 1997). Thus, claims 1 and 11 do not exclude the insert present in O'Brien's device.

Appellant argues that “the barbs of the present invention are not structurally the equivalent of the hooks of Clayton” (Br. 7). However, as we interpret the claims, the term “barb” encompasses both pointed structures like those on barbed wire or fishing hooks and the cut end portion of wire used to form an individual chain link of the type shown in Figure 3.¹ Given the breadth of the term “barb,” and Appellant’s failure to point to any specific definition distinguishing the term from the hooks on the chains of Clayton’s device, we agree with the Examiner that “barb” encompasses the hooks on Clayton’s device.

Appellant argues that certain claims “specify that each chain element includes a plurality of links and that each link includes a barb. The Examiner has no reference to substantiate his allegation that such structure would be obvious. Such naked assertion is without merit” (Br. 7).²

We are not persuaded by this argument. As noted above, the Supreme Court recently advised that the analysis under 35 U.S.C. § 103 “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative

¹ The barbs 24 on the chains shown Appellant’s Figures 1 and 3 appear to merely be the cut ends of the wires that are twisted to form the links of a chain. Thus, when viewed in light of the Specification, a “barbed” chain appears to encompass a commonly available double loop-type chain. Should prosecution resume in this application, rather than relying on Clayton’s hooks to meet the claimed “barb” element, the Examiner should consider whether it would have been obvious to substitute a prior art double loop chain for O’Brien’s chain.

² Appellant refers to claims 2 and 3, which have been canceled (Amendment 4 (December 19, 2002)). We note, however, that claims 1 and 13 recite that each chain link includes a barb.

steps that a person of ordinary skill in the art would employ.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). As discussed above, we agree with the Examiner that one of ordinary skill, being a person of ordinary creativity, would have inferred that including a hook on each chain link would have multiplied the retrieving ability of O’Brien’s device; i.e., the increased number of hooks would increase the likelihood of retrieving snagged lures. We therefore agree with the Examiner that claims 1 and 13 would have been obvious to one of ordinary skill at the time of the invention.

Appellant argues that O’Brien’s use of a rod to retrieve the device is contrary to the reel and handle recited in claims 4 and 5, and that “[n]either Clayton nor Shirk show any structure comparable to the reel and handle of the present invention” (Br. 7). We are not persuaded by this argument.

Figure 1 of O’Brien shows the lure retriever 10 being deployed with a second fishing rod 13. We agree with the Examiner that it would have been obvious to use a reel and handle with the second rod 13. Claims 4 and 5 do not recite any specific structural limitation regarding the reel and handle that distinguish them from a reel and handle that one of ordinary skill would have used with O’Brien’s retrieving rod.

Appellant also argues that claim 16 is distinguishable from the cited references because “[b]oth O’Brien and Clayton use two points at which their lines attach to their sleeves, and Shirk uses only one line. Ninety degrees is not ‘remote’ as the term is used in claim 16” (Br. 9). We are not persuaded by this argument.

Claim 16 recites only that “the slit is remote from where the line is secured to the sleeve.” Claim 16 therefore encompasses structures in which the line is attached to the sleeve at any point away from the slit. Figure 3 of Clayton shows line 15 attached to the sleeve by a spring 20 at points 20b and 20c, which are away from the location of slit 14’ on the sleeve.

To summarize, because we agree with the Examiner that one of ordinary skill would have considered the device recited in claims 1, 11, and 13 obvious in view of O’Brien and Clayton, we affirm the Examiner’s rejection of those claims. Claims 4, 5, 7, 9, 12, and 16 fall with claims 1, 11, and 13.

4. OBVIOUSNESS -- CLAIMS 6, 8, AND 14

Claims 6, 8, and 14 stand rejected under 35 U.S.C. § 103 as obvious in view of O’Brien, Clayton, and Shirk (Answer 4).

Claim 6 recites “[t]he apparatus of claim 1 in which the sleeve includes a longitudinal axis, and the slit in the sleeve extends diagonally with respect [to] the longitudinal axis.” Claim 14 recites “[t]he apparatus of claim 13 in which the slit extends diagonally on the sleeve.”

The Examiner cites O’Brien as disclosing a fishing lure retriever having a “slit in the body or sleeve extending generally parallel to the longitudinal axis” (Final Rejection 3). The Examiner cites Shirk as disclosing a fishing lure retriever with a “slit 2 in the sleeve 1 extending diagonally with respect to the longitudinal axis” (*id.*). The Examiner concludes that one of ordinary skill would have considered it obvious “to provide O’Brien with a diagonal slit as shown by Shirk since merely one

equivalent slit is being replaced with another and the function is the same and no stated problem was solved” (*id.*).

Appellant argues that the slit in the sleeve of Shirk’s fishing lure retriever is not diagonal with respect to the sleeve’s longitudinal axis (Br. 8). We are not persuaded by this argument.

Shirk states that the “slot is preferably cut so that it extends spirally about 45° to a point substantially midway of the length of the body, and then extends in the opposite direction to the other end of the body” (Shirk, col. 1, ll. 43-48). However, Shirk’s Figure 2 shows at least a portion of the slit 2 extending in a diagonal direction with respect to the longitudinal axis. Appellant’s claims 6 and 14 do not state that the slit must extend diagonally for the entire length of the sleeve.

Therefore, because Shirk’s slit extends diagonally along a significant portion of the sleeve’s length, we agree with the Examiner that Shirk’s slit meets the limitation in claims 6 and 14 that the slit extends diagonally with respect to the longitudinal axis. Because one of ordinary skill viewing Shirk would have reasoned that slits having that configuration were useful in the sleeve portion of fishing lure retrievers of the type disclosed in Shirk, O’Brien, and Clayton, we agree with the Examiner that one of ordinary skill would have considered it obvious to use a slit having Shirk’s configuration in a device such as that of O’Brien and Clayton. We therefore affirm the Examiner’s rejection of claims 6 and 14.

Appellant argues that the Examiner erred in concluding that Shirk meets the limitation in claim 8 that the line is secured to the sleeve

diametrically opposed to the slit (Br. 8). We are not persuaded by this argument.

Shirk states that “[t]he body, adjacent its top edge, is provided with a hole 3 through which is secured the lower end of a drop line 4. The whole is disposed at a point substantially 90° circumferentially from the adjacent end of the slot for the purpose hereinafter described” (Shirk, col. 1, ll. 49-54). However, as pointed out by the Examiner (Answer 5), Figure 2 of Shirk shows slit 2 on the opposite side of sleeve 1 from hole 3.

Moreover, one of ordinary skill, being a person of ordinary creativity and common sense, *see KSR*, 127 S. Ct. at 1741-42, would have inferred from the combined teachings of Shirk, O’Brien and Clayton that any positional relationship between the line attachment and slit that allowed the lure retriever to perform its function would be a useful configuration. Because Appellant points to no unexpected result coming from the configuration recited in claim 8, we agree with the Examiner that claim 8 would have been obvious to one of ordinary skill at the time of Appellant’s invention. We therefore affirm the Examiner’s rejection of claim 8.

SUMMARY

We affirm the Examiner’s rejection of claims 1, 4, 5, 7, 9-13, 15, and 16 under 35 U.S.C. § 103 as obvious over O’Brien and Clayton.

We also affirm the Examiner's rejection of claims 6, 8, and 14 under 35 U.S.C. § 103 as obvious in view of O'Brien, Clayton, and Shirk.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

dm

H. GORDON SHIELDS
7830 NORTH 23RD AVENUE
PHOENIX AZ 85021